

Remarks

Claims 42-49 and 57-73 were pending in the present application. Claims 57-73 have been cancelled without prejudice to applicants pursuing in a separate application. Claim 42 has been amended.

Applicants wish to thank the examiner for withdrawal of the objection to the abstract.

Claim Rejections Under 35 U.S.C. § 112, first paragraph (scope of enablement)

Claims 42-49 stand rejected as allegedly lacking enablement. According to the examiner, applicants "have not demonstrated the claimed reaction chemistry on a protected glycopeptide that 'has no free amino or carboxyl groups and has a free hydroxyl group only at the 6-position.'" The rejection is moot by amendment, nonetheless, applicants traverse.

Initially, applicants point out that claim 42 claims "a free primary hydroxyl group only at the 6-position of said hexose residue" (emphasis added), not merely "a free hydroxyl group only at the 6-position" as suggested by the Office Action. Applicants agree that the vancomycin compound of Scheme I has other free hydroxyls, but these hydroxyls are not "primary hydroxyls." Rather, they are "secondary hydroxyls." Indeed, the only "primary hydroxyl" group found on the vancomycin compound is "only at the 6-position of said hexose residue."

Furthermore, the subject matter of claim 42 is described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. For example, applicant's direct the Examiner's attention to Figure 7 and Examples 1 and 7. Upon reading

the specification in its entirety and, in particular, the above referenced figure and examples, one skilled in the art would be able to make and/or use the invention.

Claim Rejections Under 35 U.S.C. § 112, first paragraph (written description)

Claims 42-49 stand rejected as allegedly failing to comply with the written description requirement. According to the examiner, applicants "have not demonstrated the claimed reaction chemistry on a protected glycopeptide that 'has no free amino or carboxyl groups and has a free hydroxyl group only at the 6-position.'" The rejection is moot by amendment, nonetheless, applicants traverse.

Initially, applicants point out that claim 42 claims "a free primary hydroxyl group only at the 6-position of said hexose residue" (emphasis added), not merely "a free hydroxyl group only at the 6-position" as suggested by the Office Action. Applicants agree that the vancomycin compound of Scheme I has other free hydroxyls, but these hydroxyls are not "primary hydroxyls." Rather, they are "secondary hydroxyls." Indeed, the only "primary hydroxyl" group found on the vancomycin compound is "only at the 6-position of said hexose residue."

Furthermore, the subject matter of claim 42 is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. For example, Applicant's direct the Examiner's attention to Figure 7 and Examples 1 and 7. Upon reading of the specification in its entirety and the above referenced figure and examples, the claimed subject matter would be reasonably conveyed to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

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**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 C.F.R. § 1.116**

Conclusions

Applicants request:

- (1) entry of the amendment to the claims; and
- (2) reconsideration and withdrawal of the rejection of the claims; and
- (3) allowance of claims 42-49.

If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at the number below.

Respectfully submitted,

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